

NORDICA S.P.A.
Opposer,

IPC 14-2007-00060

-versus -

Opposition to:
TM Application No. 4-2005-006170
(Filing Date: 04 July 2005)

WILHELMINA SANTOS,
Respondent-Applicant.

TM: "NORTICA"

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Decision No. 07-70

DECISION

Before this Bureau is an Opposition filed by Nordica S.P.A., a corporation duly organized and existing under and by virtue of the laws of Italy, with business address at Via Montebelluna 5/7 – 31040, Trevignano, Italy, against Application Serial No. 4-2005-006170 for registration of the trademark "NORTICA" for rtw pants, jeans and shirts under Class 25, filed on 04 July 2005 under the name of Respondent-Applicant, Wilhelmina Santos with business address at Las Buenas Bldg., Industrial Road, Potrero, Malabon.

The grounds for the opposition to the application for registration of the trademark NORTICA are as follows:

"1. The applicant's mark "NORTICA", which clearly adopts the exact letters in opposer's mark "NORDICA" except for the letter "D" and which is confusingly similar in sound to the well-known mark NORDICA, is an act designed to ride on the goodwill of the mark NORDICA & design used for "ski boots, after ski boots, shoes, slippers, clothing for sport use, headgear, classical and free time clothing, special shoe wear for sports activities, and particularly shoe wear for resistance" in class 25

"2. The opposer's mark NORDICA & Arrow design was adopted by opposer even prior to the filing of applicant's trademark application for NORTICA in 2005. Hence, opposer's mark should be protected on the bases of Sec. 122 of the IP Code in relation to Sec.2-A of R.A. 166, and Sec. 123.1 (d) of R.A.8293.

"3. The trademark Nordica & Arrow design is known in numerous countries to be owned by the opposer. It is registered in countries worldwide. Hence, the registration of a confusingly similar trademark "NORTICA" for similar products in class 25, with the nearly exact letters as NORDICA, same arrow device, and the sound confusingly similar to the well-known mark NORDICA & Arrow design will be a breach of the clear provisions of Art. 6bis of the Paris Convention and Sec. 123 (e) of R.A. 8293 on well-known marks.

"4. Opposer hereby opposes the registration and use by applicant of this trademark "NORTICA" because of applicant's adoption of a mark confusingly similar to the mark NORDICA & Arrow design. The adoption by applicant of a confusingly similar mark NORTICA creates the same overall impression as the mark NORDICA & Arrow design. Hence, such adoption by applicant shall only diminish the distinctiveness and dilute the goodwill of opposer's trademark NORDICA & Arrow design.

"5. The appropriation by applicant of the confusingly similar mark NORTICA with the arrow at the top of the letter N likely to cause confusion on the part of the public who likely to think that the applicant's products are related to or sponsored by the opposer. There is evident bad faith on the part of the applicant in appropriating a mark that is confusingly similar to the opposer's mark NORDICA and Arrow design.

Opposer relied on the following facts to support its contentions in this Opposition:

"1. Opposer is the owner of the well-known mark NORDICA & Arrow design for "ski boots, after ski boots, boots , shows, slippers, clothing for sport use, headgear, classical and free time clothing, special shoe wear for sports activities, and shoe wear" in class 25. The registration of the mark NORDICA was first applied in Italy on March 25, 1954 and registered on December 29, 1954 under Trademark Registration No. 120272.

"2. Opposer was the owner of Philippine Trademark Registration No. 53444 for NORDICA issued on September 4, 1992 for goods in classes 3, 9, 14, 16, 18, 24, 25, and 28. Attached as Exhibit "S" is a copy of the trademark details as published on the Intellectual Property Office (IPO) electronic trademark database.

"3. In the Philippines, opposer also trademark application for Nordica & Device on December 5, 2006, for the same goods as stated above in class 25.

"4. The mark NORDICA & Arrow design has long been used internationally since 1960 by the opposer.

"5. Opposer's mark NORDICA and Arrow design is also promoted internationally through extensive sales and through advertisement.

"6. Opposer's trademark NORDICA & Arrow design has obtained international recognition and goodwill as belonging to one owner or origin, the opposer herein. In Spain, the Chamber of Commerce attested that the NORDICA trademark is well-known.

"7. In Austria, results of an opinion poll among people interested in winter sports show that 84% of the people know of the mark NORDICA.

"8. The appropriation, therefore, by applicant of the word "NORTICA" with similar letters and arrow device, and with the same pronunciation is a manifest act of a bad faith. Opposer will be damaged and prejudiced by applicant's unlawful appropriation of a confusingly similar "NORTICA".

The Notice to Answer dated March 15, 2007 was personally served to Respondent-Applicant and received on March 22, 2007 through its Counsel, Atty. George L. King, directing it to file its Verified Answer within a prescribed period from receipt. For failure of Respondent to file the required Answer within the said period, this Bureau resolved to submit the case for decision.

Considering that the case was mandatorily covered by the Summary Rules under Office Order No. 79, this Bureau directed Opposer to file all evidence in original and duplicate copies, and in compliance with said Order, Opposer through Counsel filed its evidence on March 13, 2007.

Filed as evidence for the Opposer, based on the records, are the following:

1. Print-outs of selected pages from the S.p.a. website - Exhibit "A"
2. Certified true copy of Philippine Trademark Application No. 4-2006-013133 for NORDICA & Device - Exhibit "B"
3. Certified copy of Community Trademark Application No. 2147619 for NORDICA & Device - Exhibit "C"
4. Certified copy of International Trademark 757277 for Nordica & Device - Exhibit "D"

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| 5. | Certified copy of International Trademark
549122 for Nordica & Device | - | Exhibit "E" |
| 6. | Certified copy of Thailand Trademark
Registration No. 221829 for Nordica &
Device | - | Exhibit "F-1" |
| 7. | Certified copy of Thailand Trademark
Registration No. 123380 for Nordica &
Device | - | Exhibit "F-1" |
| 8. | Certified copy of Taiwan Trademark
Registration No. 506927 for Nordica
& Device | - | Exhibit "G-1" |
| 9. | Certified copy of Taiwan Trademark
Registration No. 506927 for Nordica
& Device | - | Exhibit "G-2" |
| 10. | Certified copy of Taiwan Trademark
Registration No. 506927 for Nordica
& Device | - | Exhibit "G-3" |
| 11. | Certified copy of Canada TMA 633705
For Nordica & Device | - | Exhibit "H" |
| 12. | Certified copy of U.S. Trademark
Registration No. 3074988 For Nordica
& Device | - | Exhibit "I-1" |
| 12. | Certified copy of U.S. Trademark
Registration No. 1140419 For Nordica
& Device | - | Exhibit "I-2" |
| 13. | Certified copy of U.S. Trademark
Registration No. 1636804 For Nordica
& Device | - | Exhibit "I-3" |
| 14. | Certified copy of U.S. Trademark
Registration No. 2671287 | - | Exhibit "I-4" |
| 15. | Certified copy of U.S. Trademark
Registration No. 2336107 For Nordica
& Device | - | Exhibit "I-5" |
| 16. | Certified copy of Hong Kong Trademark
Registration No. 1890/1992 for Nordica
& Device | - | Exhibit "J" |
| 17. | Certified copy of South Korea Trademark
Registration No. 517006 for Nordica &
Device | - | Exhibit "K" |
| 18. | List consisting of 80 pages showing the | | |

	Worldwide trademark registrations and Applications for Nordica & Device	-	Exhibit "L"
19.	Certified copy of the summary of the volume of sales of Nordica products worldwide from 2000-2005	-	Exhibit "M"
20.	BCONTA, Inc. 1973 brochure showing the various Nordica products	-	Exhibit "N-1"
21.	1975 Winter catalogue of Daiwa Sporting goods Co., Ltd., showing the Nordica products for sale in Japan	-	Exhibit "N-2"
22.	Nordica brochure	-	Exhibit "N-3"
23.	ISPO China, The sports Community featuring the Nordica 2004/2005	-	Exhibit "N-4"
24.	Nordica 2004/2005 brochure on Nordica Products	-	Exhibit "N-5"
25.	Print advertisement/articles on the Internet on Nordica in Italy, Austria, Germany and France	-	Exhibit "N-6N-15"
26.	Certified copy of the summary on the amount spent for the advertising and promotion of the Nordica products from 2000-2005	-	Exhibit "O"
27.	Copy applicant's mark Nortica as shown on the IPO trademark database	-	Exhibit "P"
28.	Certification issued by the Chamber of Commerce of Spain attesting to the renown of the mark Nordica & Design	-	Exhibit "Q"
29.	Results of an opinion roll in Austria among people interested in winter sports showing that 84% of the people know of Nordica	-	Exhibit "R"
30.	Copy of the trademark details of Nordica as published on the IPO Trademark database	-	Exhibit "S"

The issue for this Office disposition is the propriety of Application Serial No. 4-2004-006170; whether or not Respondent-Applicant is entitled to register the trademark NORTICA covering goods in Class 25.

After a close scrutiny and careful evaluation of the records and evidence presented, this Bureau finds substantial evidence to prove the grounds relied upon by Opposer to sustain this instant Opposition.

On the basis of the evidence presented, there is a shown clear and convincing proof that the two (2) competing trademarks, NORDICA of Opposer and Respondent-Applicant's NORTICA are confusingly similar. The style in which the letters are written and spelled are almost the same, both containing three (3) syllables and similar prefixes and suffixes. Subject marks have both seven (7) letters, although Applicant's mark use the letter T in place of the letter D, when they are pronounced the two marks are almost the same, NORTICA is not at all phonetically different from NORDICA. For purposes of Illustration, this Bureau has adopted the declaration of the Court in the case of Celanes Corporation of America vs. E.I. Du Pont de Nemours & Co. (1946), 154F. 2d 146 148 which held that "the following have the same significance or have the same appearance and meaning:

"CELDURA" and "CORDURA" – That both marks considered as a whole are similar in meaning and appearance cannot be doubted. When spoken as written they sound very much alike. Similarity of sound alone, under such circumstances, is sufficient to cause the marks to be regarded as confusingly similar when applied to merchandise of the same descriptive properties."

Below is a side-by-side comparison between Opposer's registered mark NORDICA and Respondent-Applicant's NORTICA mark, subject of this instant suit and/or opposition. Quite evident is the arrow device which serves as Opposer's source identifier when printing the letter N. Applicant copied not just six (6) of the seven (7) letters of Opposer's mark, even the arrow device in printing the letter N which is unique and distinctive to Opposer is copied by Applicant:

Opposer's Mark

Applicant's mark

Moreover, the mark NORDICA is a coined, invented or made-up word therefore not open for appropriation by anyone. It is word that does not exist in any dictionary; examples of famous coined words are the trademarks Rolex, Kodak and Kotex, to name a few. The adoption of such coined word in Opposer's business excludes others similarly situated from using the same, hence, the use by Respondent of the mark NORTICA vis-à-vis Opposer's NORDICA as applied to similar goods may lead to confusion in trade and would damage obviously Opposer's business.

Moreover, the goods involved are the same, they pertain to clothing or wearing apparel falling under Class 25 of the International Classification of Goods. Thus, applying these competing marks to the same goods which passed through the same channels of trade and marketed similarly may lead to confusion in trade and would damage Opposer's goodwill or reputation which it has painstakingly earned and established for quite and/or considerable period of time.

In like manner, the Supreme Court made the following pronouncements to the effect that:

"The tradename "LIONPAS" for medicated plaster cannot be registered because it is confusingly similar to "SALONPAS", a registered trademark also for medicated plaster. x x x Although the two letters of "SALONPAS" are missing in "LIONPAS", the first letter a and the letter s. Be that as it may, when the two words are pronounced, the sound effects are confusingly similar. "(Marvex Commercial Co. Hawpia & Co., 18 SCRA 1178),

"The similarity between the two competing trademark, DURAFLEX and DYNAFLEX is apparent. Not only are the initial letters and the last half of the appellations identical but the difference exists in only two out of the eight literal elements of the designations. Coupled with the fact that both marks

cover insulated flexible wired under Class 20; x x x no difficulty is experienced in reaching the conclusion that there is a deceptive similarity that would lead the purchaser to confuse one product with the other.” (American Wire and Cable Co. vs. Director of Patents, 31 SCRA 544),

In the language of R.A. 8293, more particularly Section 123 (d), it is said that:

“Section 123. Registrability. – 123.1 A mark cannot be registered if it:

xxx

(d) Is identical with a registered mark belonging to a different proprietor or mark an earlier filing or priority date, in respect of:

- (i) The same goods or services, or
- (ii) Closely related goods or services, or
- (iii) If it nearly resembles such a mark as to be likely to deceive or cause confusion;”

xxx

It is clear from a reading of Section 123(d) as above cited that the intentions of the law is protect not only the owner of the trademark, likewise, and more importantly, the buying public that they may not be confused, mistaken or deceived by the goods they purchase.

Moreover, in the case of Converse Rubber Corp. vs. Universal Rubber Products, Inc. where the concept of likelihood of confusion was clearly discussed, thus, “The similarity in the general appearance of respondent’s trademark and that of petitioner would evidently create a likelihood of confusion among the purchasing public. xxx The risk damage is not limited to a possible confusion of goods but also includes of the parties originated from the same source.” The law does not require actual confusion, it suffices that conclusion is likely to occur in the sales of the goods and adoption of both marks (Philips Export B.V., et. al vs. Court of Appeals, et al G.R. NO. 96161, February 21, 1992). Hence, the likelihood that prospective buyers may perceive that Respondent’s goods are manufactured by or is associated or connected with Opposer is probable.

Opposer is the registered owner and prior user of the trademark NORDICA. Way back in the 50s in Italy for example, Opposer already ventured in the sale goods falling under Class 25 and obtained its first Philippine registration in the year 1992. Opposer has shown prior registration in the Philippines and abroad for other falling under classes 03, 09, 14, 16, 18, 24, 25, and 28, more than five (5) decades earlier that Respondent’s application for the mark NORTICA as applied to goods falling under class 25.

It is worth mentioning at this juncture to bolster Oppositor’s exclusive right over its NORDICA trademark and accord protection henceforth against any subsequent user is the established goodwill and reputation NORDICA trademark has earned over the years. The trademark NORDICA is widely and popularly used by the Opposer abroad especially on its winter clothing. Opposer’s products using the trademark NORDICA are promoted, advertised and sold through Opposer’s website www.nordica.com, among other channels of trade. The use and adoption by Applicant of the mark as subsequent user can only mean that Applicant wishes to reap on the goodwill, benefit from the advertising value and reputation of Opposer’s NORDICA trademark.

Therefore, on the basis of the evidence presented and as the record eloquently shows, Opposer’s mark, NORDICA, has registrations and pending applications in the name of the Opposer in many countries in the world and has enjoyed international reputation and goodwill for the quality of the products they sell bearing the trademark. Over the years, Opposer’s principal

products like winter clothing and sports apparel bearing NORDICA trademark have been sold by the Company, Nordica S.p.a., Opposer herein, in many countries worldwide.

By appropriating a word so closely resembles that of widely and popularly used trademark, and taking into account the evidence submitted by Opposer, this Office is of the opinion that indeed there was deliberate intent by Respondent-Applicant to ride on the popularity of the mark of the Opposer generated through extensive use and advertisement without the Respondent-Applicant having incurred any expense to gain such goodwill and/or reputation. Likewise in the case of American Wire & Cable Co. vs. Director of Patents, 31 SCRA 544, it was observed that:

“Why of the million of terms and combination of letters and designs available the appellee had to choose so closely similar to another’s trademark if there was no intent to take advantage of the goodwill generated by the other mark”

In like manner, the court in a long line of cases ruled thus:

“Those who desire to distinguish their goods from the goods of another have a broad field from which to select a trademark for their wares and there is no such poverty in English language or paucity of signs, symbols, numerals etc. as to justify one who really wishes to distinguish his products from the other entering the twilight zone of or field already appropriated by another (Weco Products Co., Milton Ray Co., 143 F. 2d. 985, 32 C.C.P.A. Patents 1214).

“xxx why, with all the birds in the air, and all fishes in the sea, and all the animals on the face of the earth to choose from, the Defendant company (Manila Candy Co.) elected two roosters as its trademark, although its directors and managers must have been well aware of the long continued use of a rooster by the plaintiff with the sale and achievement of its goods/ x x x a cat, a dog, a carabao a shark, or an eagle stamped upon the container in which candies are sold would serve as well as rooster for the product of Defendants factory. Why did defendant select two roosters as its trademark? (Clarke vs. Manila Candy Co., 36 Phil 100).”

The Opposer having sufficiently corroborated its claim, the inevitable Conclusion is that Opposer is the first adopter and user of the mark NORDICA and that the mark NORTICA bearing Application Serial No. 4-2005-006170 cannot have any right superior to Opposer’s trademark NORDICA used on goods falling under Class 25.

WHEREFORE, premises considered, the Notice of Opposition is, as it is hereby SUSTAINED. Consequently, application bearing Serial No. 4-2005-006170 filed by Wilhelmina on July 04, 2005 for the registration of the Mark “NORTICA” for use on goods falling under class 25 is it is hereby REJECTED.

Let the filewrapper of NORTICA, subject matter of this case together with a copy of this Decision be forwarded to the Bureau of Trademarks for appropriate action.

SO ORDERED.

Makati City. 13 June 2007.

ESTRELLITA BELTRAN-ABELARDO
Director, Bureau of Legal Affairs
Intellectual Property Office